APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,773	12/31/1998	GREGORY S. LINDHORST	3797.09761	3335

28319 7590 11/17/2004	EXAMINER	
BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET , N.W. ELEVENTH STREET WASHINGTON, DC 20001-4597	QUELER, ADAM M	
	ART UNIT	PAPER NUMBER
	2179	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/223,773	Applicant(s) LINDHORST ET AL.
	Examiner Adam M Queler	Art Unit 2179

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 08 September 2004 .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

    4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed on 9/8/2004.

2.   Claims 1-20 are pending in the case. Claims 1, 8, and 17 are independent claims. Claims 17-20 have been withdrawn.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/8/2004 has been entered.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   **Claims 1-16** remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Receiving input for a first event-driven program is not disclosed in the specification. From, the specification and interviews with Applicant's representatives, it is clear that the "event-driven program" as claimed is intended to be the "design-time control" from the specification. However, the claims read on the "first event driven program" being the program

that the properties are inputted into. The DTC in the specification cannot be considered a program. The Office believes that Applicant is intending for "event-driven" to mean object-oriented. This is shown in specification as the description of the environment (p. 17, ll. 16-19). Upon further examination of the specification it appears Applicant is using this terminology due to the fact that the objects are communicating with events. As they are communication with events, the terminology "event-driven" is acceptable. However, the use of serial-execution code is still not taught. In the example in the specification that allegedly covered the claimed subject matter (p. 24, ll. 17-22), the code examples both represent event-driven code, dependent on an event being fired, "onclick." Applicant discloses a similar example on page 26, ll. 4-8. The Office suggests "imperative code," "procedural code" or eliminating the phrase entirely. **Regarding dependent claim 7**, it is not clear how changing an object to code equivalent to the object, and then changing the code back to an object equivalent to the code would result in a different program.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   **Claims 1-16** remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to deficiencies in the disclosure noted above, it is not apparent how this claimed subject matter is possible. While the Office recognizes the right of the Applicant to be their own lexicographer, in this case Applicant has given terms meanings repugnant to their definitions. MPEP § 608.01(o) states, "No term may be given a meaning repugnant to the usual meaning of the term." Therefore, for examining purposes only "serial-

execution code" will be taken to mean HTML, which is not the same thing as serial-execution

code. Also "program" will be broadly interpreted to mean some type of object or container.

Applicant repeatedly relates the "code" and the "program" using the term "represented." The

meaning of this relationship is not clear. From the above discussion, it appears that a

corresponding relationship is the desired meaning, and will be treated as such for examining

purposes only.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson

et al (US005956736A, filed 9/27/1996), and further in view of Popp (US006651108B2, filed

8/14/1995).

Regarding independent claim 1, Hanson teaches receiving input from a designer, comprising

an object with properties (col. 4, ll. 26-39), which also can be event-driven (col. 8, ll. 10-17).

Hanson teaches converting and outputting HTML that is a representation of the object (col. 4, ll.

43-45). Hanson does not teach reconverting HTML to objects. Popp teaches converting an

HTML document into objects based on the HTML. It would have been obvious to one of

ordinary skill in the art at the time of the invention to combine Popp with Hanson because the

text form of HTML cannot be easily extended and specialized like objects can (Hanson, col. 4, ll. 19-20).

Regarding dependent claim 2, Hanson teaches client receiving HTML (serial execution code) from a server (col. 3, ll. 23-29). All programs (objects) on all web pages "operate between a client and a server" as they are transmitted. Hanson teaches an editor that treats all objects the same; therefore, it is shown as operating as if they are on a single machine (col. 4, ll. 26-39).

Regarding dependent claim 3, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39).

Regarding dependent claim 4, Hanson teaches adding scripts to a script library for later placement (col. 13, ll. 20-50).

Regarding dependent claim 5, Hanson discloses controls for generating objects (col. 7, ll. 25-28).

Regarding dependent claim 6, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39). Hanson teaches converting and outputting HTML that is a representation of the object (col. 4, ll. 43-45). Hanson does not teach reconverting HTML to objects. Popp teaches converting an HTML document into objects based on the HTML. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Popp with Hanson because the text form of HTML cannot be easily extended and specialized like objects can (Hanson, col. 4, ll. 19-20).

As this conversion changes an object to code equivalent to the object, and then changes the code back to an object equivalent to the code, inherently the objects are the same.

Regarding dependent claim 7, Neither Hanson or Popp explicitly discloses the first and second

program being the same. However, it would have been obvious to one of ordinary skill in the art

at the time of the invention that slight difference would appear in the conversion, rendering them

different programs.

Regarding dependent claim 15, Hanson teaches that markup language is HTML (col. 4, ll. 43-

45).

Regarding Claims 8-14 and 16, the methods encompassing the same limitations as claims 1-7

and 15 are rejected under the same rationale.

Response to Arguments

8.   **Applicant's arguments filed 9/8/2004 have been fully considered but they are not**

persuasive.

Regarding Applicant's remarks on the §112 rejections:

Applicant has alleged that the amendment renders the rejection moot. The Office disagrees, and

the rejection can be found above.

Regarding Applicant's remarks on claim 1:

Applicant alleges that Hanson does not disclose event-driven programs. Hanson teaches

receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39), which

also can be event-driven (col. 8, ll. 10-17).

Applicant alleges that Hanson fails to teach converting a property of an object and only discloses

dragging to editor. However, as expressly cited in the rejection, Hanson's object outputs it's

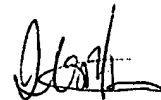contents, which would include the properties, as HTML on a server (col. 4, ll. 43-45).

In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

STEPHEN S. HONG
PRIMARY EXAMINER